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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,809	08/21/2001	Ronald E. Griffin	0020012. P001	8815

7590

08/10/2004

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EXAMINER

DUONG, THANH P

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/934,809	GRIFFIN, RONALD E.	
	Examiner	Art Unit	
	Tom P Duong	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-15,17-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-15,17-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment and accompany remarks filed on 04/14/04 have been entered and carefully considered.

The amendment is sufficient to overcome the claim objections. Claims 1,2, 4-11, 13-15, 17-24, and 26-30 are remains pending

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Caldwell (3,578,332). Caldwell discloses the golf club of the claimed invention (Figures 1-5 and Col. 1, lines 36-53).
2. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernhardt (4,265,451). Bernhardt discloses the golf club of the claimed invention (Figure 6).
3. Claims 1 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Giordano (6,179,727). Giordano discloses the golf club of the claimed invention (Figures 1-3).

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4. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevenson, Jr. (5,333,870). Stevenson, Jr. discloses the golf club of the claimed invention (Figures 1 and 11 and Col. 9, lines 54-68).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4-11, 13, 15, 17-24, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell '332 in view of Stevenson, Jr. '870 and Rife (5,618,239) and Ashcraft (6,261,190). Caldwell '332 discloses a putter head with a narrow sole 16 and a rear section sculpted (Fig. 3) with enlargement 13 near the shaft and head attachment (Col. 1, lines 50-53) facilitates ball alignment and improves propulsion force (Col. 2, lines 22-27). Caldwell does not disclose alignment means and a striking face with non-radial curvature (convex striking face with grooves). Caldwell appears to show the bottom rear portion curved rearwardly and upwardly similar to the doze portion of the claimed invention. Likewise, Stevenson also discloses a narrow sole and the backside 12 is slanted backward (Fig. 11) to concentrate more mass at the top surface 3 or shaft attachment of the head. Rife teaches that the grooves 302 of a convex striking face with one degree loft (Fig. 8) creates an overspin or rolling action, which provides more control to a golf ball upon impact. Ashcraft teaches an alignment

feature 50, which allows a golfer to align the putter with the golf ball (Col. 1, lines 35-38 and Col. 3, lines 49-54). Thus, it would have been obvious in view of Stevenson and Rife and Ashcraft to one having ordinary skill in the art to modify the putter of Caldwell with the backside slanted backward as taught by Stevenson, grooves on the striking face as taught by Rife, and alignment feature as taught by Ashcraft in order to provide a putter of Caldwell with mass concentration at the shaft, overspin action for a golf ball, and alignment feature. The above combination features essentially enhance the performance of Caldwell's putter. With respect to the loft angle in claims 8, 20 and 28, it is conventional to provide a striking face with positive loft angle to ensure the golf ball have a pure rolling motion, which minimizes the golf ball from deviating from its intended path and it would have been obvious to do so here to gain the same benefit.

Response to Arguments

Applicant's arguments filed 4/14/04 have been fully considered but they are not persuasive. In response to the Remarks with respect to the 102 rejections, claims 1 and 14 structurally read on the apparatus of Caldwell, Bernhardt, Giordano, and/or Stevenson, Jr. Therefore, claims 1 and 14 are anticipated by the applied references.

With respect to the alignment means, Applicant argues that the Ashcraft reference fails to show the alignment means "frame" the ball and the alignment means of Ashcraft consist of two tiered or sections. Examiner respectfully disagrees since Figure 2 of Ashcraft clearly shows top face with alignment means 50, which "frames" the golf ball 74 (Col. 3, lines 20-40).

In response to applicant's argument that the sole with slanted doze portion facilitates in brushing back against the taller grass and allowing smooth stroke, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to the non-radial curvature of the striking face, Rife clearly shows a non-radial curvature extending across the striking face as shown in Figure 8. Note, the grooves on the surface of the striking face control the spin rates of the ball and provides a pure rolling motion of the ball.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "roll and bulge" of the non-radial surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to the sculpted in the rear section, Caldwell shows the rear portion as shown in Figure 3 with sculpted rear section.

With respect to the 1-degree non-radial contour of the striking face, Rife shows a non-radial contour with one-degree loft to minimize backspin as shown in Figure 8. It

would have been obvious to modify the striking face of Caldwell with a non-radial contour with one-degree loft as taught by Rife in order to minimize backspin or provide a pure rolling of the golf ball.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (571) 272-2794. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Duong
August 9, 2004

TD



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